

ESTTA Tracking number: **ESTTA691411**Filing date: **08/24/2015**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**Petition for Cancellation**

Notice is hereby given that the following party requests to cancel indicated registration.

Petitioner Information

Name	MedStar Health, Inc.		
Entity	Corporation	Citizenship	Maryland
Address	5565 Sterrett Place 5th Floor Columbia, MD 21044 UNITED STATES		

Attorney information	CORY M. AMRON VORYS, SATER, SEYMOUR AND PEASE LLP IPLAW@VORYS - PO BOX 2255 COLUMBUS, OH 43216 UNITED STATES iplaw@vorys.com, tmcurcio@vorys.com, cmamron@vorys.com, whol- dach@vorys.com Phone:202-467-8800
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Registration Subject to Cancellation

Registration No	3838606	Registration date	08/24/2010
Registrant	Fearsome Fivesome, LC 13812 Flat Top Ranch Road Austin, TX 78732 UNITED STATES		

Goods/Services Subject to Cancellation

Class 036. First Use: 2010/02/01 First Use In Commerce: 2010/02/01 All goods and services in the class are cancelled, namely: Medical accounts receivable financing, namely, the purchase of receivables secured by assignment from medical providers and subsequent resale of the receivables to third parties
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Grounds for Cancellation

The registration is being used by, or with the permission of, the registrant so as to misrepresent the source of the goods or services on or in connection with which the mark is used.	Trademark Act section 14
Priority and likelihood of confusion	Trademark Act section 2(d)
Dilution	Trademark Act section 43(c)

Marks Cited by Petitioner as Basis for Cancellation

U.S. Registration No.	1327545	Application Date	03/16/1984
Registration Date	03/26/1985	Foreign Priority	NONE

		Date	
Word Mark	MEDSTAR		
Design Mark	MEDSTAR		
Description of Mark	NONE		
Goods/Services	Class 042. First use: First Use: 1979/06/00 First Use In Commerce: 1979/06/00 Providing an Emergency Care Facility for Critically Ill and Injured Persons		

U.S. Registration No.	1498006	Application Date	04/28/1986
Registration Date	07/26/1988	Foreign Priority Date	NONE
Word Mark	MEDSTAR		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 036. First use: First Use: 1985/07/10 First Use In Commerce: 1985/07/10 INSURANCE BROKERAGE AND INSURANCE ADMINISTRATION SERVICES		

U.S. Registration No.	3009989	Application Date	08/15/2003
Registration Date	11/01/2005	Foreign Priority Date	NONE
Word Mark	MEDSTAR SPORTSHEALTH		
Design Mark	MEDSTAR SPORTSHEALTH		
Description of Mark	NONE		
Goods/Services	Class 044. First use: First Use: 2003/06/00 First Use In Commerce: 2003/06/00 Medical and healthcare services offered to active individuals, athletes and athletic teams		

U.S. Registration No.	2828750	Application Date	12/21/1998
Registration Date	04/06/2004	Foreign Priority Date	NONE
Word Mark	MEDSTAR		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 042. First use: First Use: 1979/06/00 First Use In Commerce: 1979/06/00 medical and hospital services		

U.S. Application/ Registration No.	NONE	Application Date	NONE
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Registration Date	NONE
Word Mark	MEDSTAR
Goods/Services	medical and hospital services

Attachments	73470690#TMSN.png(bytes) 76538519#TMSN.png(bytes) Petition to Cancel MEDSTAR FUNDING (3838606).pdf(113622 bytes) Ex. A- MEDSTAR FUNDING.pdf(787407 bytes) Ex. B- MEDSTAR FUNDING.pdf(467707 bytes) Ex. C- MEDSTAR FUNDING.pdf(381506 bytes)
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/tmc/
Name	Tanya Marie Curcio
Date	08/24/2015

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

MEDSTAR HEALTH, INC.,

Petitioner,

v.

FEARSOME FIVESOME, LC,

Registrant.

Cancellation No. _____

In the matter of Trademark Registration No. 3,838,606

Mark: MEDSTAR FUNDING

Registration Date: August 24, 2010

PETITION TO CANCEL

MedStar Health, Inc. (“Petitioner”) is a Maryland corporation with an address of 5565 Sterrett Place, 5th Floor, Columbia, Maryland 21044.

According to the Trademark Office Records, Fearsome Fivesome, LC (“Registrant”) is a Texas limited liability company with an address of 13812 Flat Top Ranch Road, Austin, Texas 78732 and owns U.S. Trademark Registration No. 3,838,606 (the “Registration”) for the mark MEDSTAR FUNDING.

Petitioner believes that it is and will continue to be damaged by the Registration and petitions to cancel it as set forth below.

FACTUAL BACKGROUND

1. Petitioner operates various hospitals and health-related businesses in Maryland, Virginia, and Washington, DC.

2. Petitioner has used the mark MEDSTAR (“Petitioner’s Mark”) in connection with various medical and hospital services since at least as early as June 1979.

3. Opposer is the owner of several prior incontestable registrations for the mark MEDSTAR for *medical and hospital services* (“Petitioner’s Services”) the earliest of which was registered March 26, 1985, Registration Number 1,327,545. The other prior incontestable registrations for or incorporating the mark MEDSTAR owned by Petitioner for medical related goods and services include: Copies of the TESS records are attached as Exhibit A.

Mark	Registration No.	Registration Date
MEDSTAR	1,498,006	July 26, 1988
MEDSTAR	2,828,750	April 6, 2004
MEDSTAR SPORTSHEALTH	3,009,989	November 1, 2005

4. On December 5, 2008, Registrant filed an intent to use application for the mark MEDSTAR FUNDING (“Mark”) that ultimately matured to the Registration for use in connection with *Medical accounts receivable financing, namely, the purchase of receivables secured by assignment from medical providers and subsequent resale of the receivables to third parties* (“Services”), claiming to have used the mark in commerce since February 1, 2010.

5. Upon information and belief, Registrant has expanded its Services to provide funding of medical and surgical procedures for hospital and medical patients using the Mark.

6. The Application was published for opposition on April 14, 2009.

7. The Registration was issued August 24, 2010.

COUNT I: LIKELIHOOD OF CONFUSION

8. Petitioner re-alleges and incorporates by reference paragraphs 1 through 7 of this Petition as if fully set forth herein.

9. Petitioner's Marks and Registrant's Mark prominently feature the term MEDSTAR.

10. The word "Funding" in Registrant's Mark is disclaimed.

11. Petitioner's Marks and Registrant's Mark give the same commercial impression.

12. Petitioner's Marks and Registrant's Mark are confusingly similar.

13. Registrant's Services are highly related to Petitioner's Services.

14. Registrant's Services and Petitioner's Services are marketed to the same types of consumers.

15. Through Petitioner's long use of Petitioner's Mark for hospital and medical related services, Petitioner's Mark has a strong reputation for rendering high quality medical services.

16. Petitioner has used Petitioner's MEDSTAR mark in connection with Petitioner's Services for almost 30 years before the filing date of the application which matured into the Registration, December 5, 2008.

17. Petitioner filed its first federal application for Petitioner's MEDSTAR mark almost 25 years before the filing date of the application which matured into the Registration, December 5, 2008.

18. Petitioner has used Petitioner's MEDSTAR mark in connection with Petitioner's Services prior to any date upon which Registrant can rely.

19. Because of the similarity between Petitioner's Marks and Registrant's Mark, and the relatedness of Petitioner's Services and Registrant's Services, Registrant's Mark is likely to cause confusion, cause mistake or deceive the public, and cause the public to believe, incorrectly,

that Registrant's Services emanate from, are authorized or endorsed by, or are otherwise connected with Petitioner in violation of Section 2(d) of the Lanham Act, 15 U.S.C. §1052(d).

COUNT II: DILUTION BY TARNISHMENT

20. Petitioner re-alleges and incorporates by reference paragraphs 1 through 7 of this Petition as if fully set forth herein.

21. Petitioner's Mark has become famous well prior to the filing of the application that matured into the Registration and the date of first use alleged by Registrant.

22. Upon information and belief, Registrant's Mark has recently been associated in the media with deceptive business practices relating to funding medical and surgical procedures.

23. Registrant's Mark is virtually identical to Petitioner's Mark, as to dilute by tarnishment or be likely to cause dilution by tarnishment, of the distinctive quality and goodwill of Petitioner's famous mark in violation of Section 43(c) of the Lanham Act, 15 U.S.C. §1125(c).

COUNT III: MISLEADING USE

24. Petitioner re-alleges and incorporates by reference paragraphs 1 through 7 of this Petition as if fully set forth herein.

25. Petitioner has used the colors blue and gold in connection with Petitioner's Services and the Petitioner's Mark since at least as early as 2006.

26. In 2008, Registrant filed an intent to use trademark application for a design mark incorporating the words MEDSTAR FUNDING in blue with the letter "a" in the word "medstar" replaced with a green star which matured into Registration Number 3,785,703. A copy of the TESS record is attached as Exhibit B.

27. Registrant has since changed the color of its logo on its website to incorporate Petitioner's signature colors, blue and gold and, in 2010, filed a new trademark application for its MEDSTAR FUNDING design mark but now claiming Petitioner's signature colors, blue and gold. Said application has matured in the Registration Number 3,904,370. A copy of the TESS record is attached as Exhibit C.

28. Upon information and belief, Registrant has actual knowledge of Petitioner's use of the mark MEDSTAR.

29. Upon information and belief, Registrant deliberately began using and is currently using the term MEDSTAR without the term FUNDING.

30. Upon information and belief, Registrant has expanded its services bearing the Mark from *Medical accounts receivable financing, namely, the purchase of receivables secured by assignment from medical providers and subsequent resale of the receivables to third parties* to services more closely related to Petitioner's Services such as funding medical and surgical procedures for hospital and medical patients.

31. By changing the use of its Mark to incorporate Petitioner's signature colors; adopting use of the mark MEDSTAR without the term FUNDING; and using the revised Mark in connection with services that are more closely related to Petitioner's Services, Registrant is a deliberately using the Mark to misrepresent the source of the Services in connection with which the Mark is used in violation of Section 14(3) of the Lanham Act, 15 U.S.C. §1064(3).

* * *

THEREFORE, Petitioner prays that the Trademark Trial and Appeal Board sustain this Petition and cancel Registration No. 3,838,606 for MEDSTAR FUNDING.

The required fee accompanies this Petition. Please charge any additional fees to Deposit Account No. 50-6424.

Please recognize Cory M. Amron, William H. Oldach III, Tanya Curcio and Laura T. Geyer, all members of the bar of the District of Columbia, and the firm of Vorys, Sater, Seymour and Pease, LLP, as Petitioner's attorneys to prosecute this Petition to Cancel.

Respectfully submitted,



Date: August 24, 2015

Cory M. Amron
William H. Oldach III
Tanya M. Curcio
Laura T. Geyer
VORYS, SATER, SEYMOUR & PEASE LLP
1909 K Street, NW
Ninth Floor
Washington, DC 20006
Telephone: 202.467.8800
E-Mail: iplaw@vorys.com

Attorney for Petitioner
MEDSTAR HEALTH, INC.

CERTIFICATE OF SERVICE

I certify that a true and correct copy of the foregoing Petition to Cancel was served on August 24, 2015, by first-class United States Mail, postage prepaid, on:

President
Fearsome Fivesome, LC
13812 Flat Top Ranch Road
Austin, TX 78732

A handwritten signature in black ink, reading "Tanya Marie Curcio". The signature is written in a cursive style with a large, sweeping initial "T".

Tanya Marie Curcio

EXHIBIT A



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MEDSTAR

Word Mark	MEDSTAR
Goods and Services	IC 042. US 100. G & S: Providing an Emergency Care Facility for Critically Ill and Injured Persons. FIRST USE: 19790600. FIRST USE IN COMMERCE: 19790600
Standard Characters Claimed	
Mark Drawing Code	(4) STANDARD CHARACTER MARK
Serial Number	73470690
Filing Date	March 16, 1984
Current Basis	1A
Original Filing Basis	1A
Published for Opposition	January 15, 1985
Change In Registration	CHANGE IN REGISTRATION HAS OCCURRED
Registration Number	1327545
Registration Date	March 26, 1985
Owner	(REGISTRANT) Washington Healthcare Corporation CORPORATION D.C. 100 Irving St. NW. Washington D.C. 20010 (LAST LISTED OWNER) MEDSTAR HEALTH, INC. CORPORATION MARYLAND 5565 Sterret Place Columbia MARYLAND 21044
Assignment Recorded	ASSIGNMENT RECORDED
Attorney of Record	CORY M. AMRON
Description of Mark	Color is not claimed as a feature of the mark.
Type of Mark	SERVICE MARK
Register	PRINCIPAL
Affidavit Text	SECT 15. SECT 8 (6-YR). SECTION 8(10-YR) 20140414.
Renewal	2ND RENEWAL 20140414
Live/Dead Indicator	LIVE

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Typed Drawing

Word Mark	MEDSTAR
Goods and Services	IC 036. US 102. G & S: INSURANCE BROKERAGE AND INSURANCE ADMINISTRATION SERVICES. FIRST USE: 19850710. FIRST USE IN COMMERCE: 19850710
Mark Drawing Code	(1) TYPED DRAWING
Serial Number	73595520
Filing Date	April 28, 1986
Current Basis	1A
Original Filing Basis	1A
Published for Opposition	November 18, 1986
Registration Number	1498006
Registration Date	July 26, 1988
Owner	(REGISTRANT) BENEFIT TRUST LIFE INSURANCE COMPANY CORPORATION ILLINOIS 400 FIELD DRIVE LAKE FOREST ILLINOIS 600452581 (LAST LISTED OWNER) MEDSTAR HEALTH, INC. CORPORATION MARYLAND 5565 STERRET PLACE COLUMBIA MARYLAND 21044
Assignment Recorded	ASSIGNMENT RECORDED
Attorney of Record	Cory M. Amron
Type of Mark	SERVICE MARK
Register	PRINCIPAL
Affidavit Text	SECT 15. SECT 8 (6-YR). SECTION 8(10-YR) 20080730.
Renewal	1ST RENEWAL 20080730
Live/Dead Indicator	LIVE

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Typed Drawing

Word Mark	MEDSTAR
Goods and Services	IC 042. US 100 101. G & S: medical and hospital services. FIRST USE: 19790600. FIRST USE IN COMMERCE: 19790600
Mark Drawing Code	(1) TYPED DRAWING
Serial Number	75609582
Filing Date	December 21, 1998
Current Basis	1A
Original Filing Basis	1A
Published for Opposition	January 13, 2004
Registration Number	2828750
Registration Date	April 6, 2004
Owner	(REGISTRANT) MEDSTAR HEALTH, INC. CORPORATION MARYLAND 5565 Sterrett Place 5th Floor Columbia MARYLAND 21044
Assignment Recorded	ASSIGNMENT RECORDED
Attorney of Record	Cory M. Amron
Prior Registrations	1327545;AND OTHERS
Type of Mark	SERVICE MARK
Register	PRINCIPAL
Affidavit Text	SECT 15. SECT 8 (6-YR). SECTION 8(10-YR) 20130917.
Renewal	1ST RENEWAL 20130917
Live/Dead Indicator	LIVE

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MEDSTAR SPORTSHEALTH

Word Mark	MEDSTAR SPORTSHEALTH
Goods and Services	IC 044. US 100 101. G & S: Medical and healthcare services offered to active individuals, athletes and athletic teams. FIRST USE: 20030600. FIRST USE IN COMMERCE: 20030600
Mark Drawing Code	(1) TYPED DRAWING
Serial Number	76538519
Filing Date	August 15, 2003
Current Basis	1A
Original Filing Basis	1B
Published for Opposition	June 21, 2005
Registration Number	3009989
Registration Date	November 1, 2005
Owner	(REGISTRANT) MEDSTAR HEALTH, INC. CORPORATION MARYLAND 5565 STERRET PLACE 5TH FLOOR COLUMBIA MARYLAND 21044
Assignment Recorded	ASSIGNMENT RECORDED
Attorney of Record	Cory M. Amron
Prior Registrations	1327545;2828750
Disclaimer	NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "SPORTSHEALTH" APART FROM THE MARK AS SHOWN
Type of Mark	SERVICE MARK
Register	PRINCIPAL
Affidavit Text	SECT 15. SECT 8 (6-YR).
Live/Dead Indicator	LIVE

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EXHIBIT B



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Word Mark	MEDSTAR FUNDING
Goods and Services	IC 036. US 100 101 102. G & S: Medical accounts receivable financing, namely, the purchase of receivables secured by assignment from medical providers and subsequent resell of the receivables to third parties. FIRST USE: 20100201. FIRST USE IN COMMERCE: 20100201
Mark Drawing Code	(3) DESIGN PLUS WORDS, LETTERS, AND/OR NUMBERS
Design Search Code	01.01.09 - Stars, two; Two stars 01.01.13 - Stars - multiple stars with five points 27.03.05 - Objects forming letters or numerals
Trademark Search Facility	LETTER-3-OR-MORE MED Combination of three or more letters as part of the mark
Classification Code	SHAPES-ASTRO Astronomical shapes consisting of celestial bodies, globes and geographical maps SHAPES-COLORS-3-OR-MORE Design listing or lined for three or more colors
Serial Number	77627753
Filing Date	December 5, 2008
Current Basis	1A
Original Filing Basis	1B
Published for Opposition	April 14, 2009
Registration Number	3785703
Registration Date	May 4, 2010
Owner	(REGISTRANT) Fearsome Fivesome, LC DBA MedStar Funding LIMITED LIABILITY COMPANY TEXAS 13812 Flat Top Ranch Road Austin TEXAS 78732
Attorney of Record	C. Russell Riddle
Disclaimer	NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "FUNDING" APART FROM THE MARK AS SHOWN
Description of Mark	The color(s) blue, green and white is/are claimed as a feature of the mark. The mark consists of A white rectangle, outlined in blue. Within the rectangle are the letters "MEDST R FUNDING" in blue. Between the letters "T" and "R" is a white star, outlined in green, with a solid green star in the middle.
Type of Mark	SERVICE MARK
Register	PRINCIPAL
Live/Dead Indicator	LIVE

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Word Mark	MEDST R FUNDING
Goods and Services	IC 036. US 100 101 102. G & S: Medical accounts receivable financing, namely, the purchase of receivables secured by assignment from medical providers and subsequent resell of the receivables to third parties. FIRST USE: 20100215. FIRST USE IN COMMERCE: 20100215
Mark Drawing Code	(3) DESIGN PLUS WORDS, LETTERS, AND/OR NUMBERS
Design Search Code	01.01.09 - Stars, two; Two stars 01.01.13 - Stars - multiple stars with five points
Trademark Search Facility Classification Code	SHAPES-ASTRO Astronomical shapes consisting of celestial bodies, globes and geographical maps SHAPES-COLORS-2 Design listing or lined for two colors SHAPES-MISC Miscellaneous shaped designs
Serial Number	85054420
Filing Date	June 3, 2010
Current Basis	1A
Original Filing Basis	1A
Published for Opposition	October 26, 2010
Registration Number	3904370
Registration Date	January 11, 2011
Owner	(REGISTRANT) Fearsome Fivesome, LC DBA MedStar Funding LIMITED LIABILITY COMPANY TEXAS 13812 Flat Top Ranch Road Austin TEXAS 78732
Attorney of Record	C. Russell Riddle
Prior Registrations	3785703;3838606
Disclaimer	NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "FUNDING" APART FROM THE MARK AS SHOWN
Description of Mark	The color(s) blue, gold and white is/are claimed as a feature of the mark. The mark consists of a white rectangle, outlined in blue. Within the rectangle are the letters "MEDST R FUNDING" in blue. Between the letters "T" and "R" is a white star, outlined in gold, with a solid gold star in the middle.
Type of Mark	SERVICE MARK
Register	PRINCIPAL
Live/Dead Indicator	LIVE

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